

## **REMARKS/ARGUMENTS**

The Applicant has carefully considered this application in connection with the Office Action and respectfully requests reconsideration of this application in view of the foregoing amendment and the following remarks.

The Applicant originally submitted Claims 1-29 in the application. In previous responses the Applicant added Claims 30-47, canceled Claims 1-47, presented Claims 48-85 for examination and subsequently amended Claims 48, 53, 62, 72 and 77. No claim amendments are presented in this response. Accordingly, Claims 48-85 are currently pending in the Application.

### **I. Substance of Applicant-Initiated Interview**

The Applicant's undersigned representative contacted the Examiner on March 25, 2011 to discuss the substance of Section II presented below. No agreements were reached in this conversation. The Applicant wishes to convey his appreciation for the courtesies extended by the Examiner in this discussion.

### **II. Remarks Regarding the February 3 Office Action**

The Applicant submitted claim amendments in a response filed November 15, 2010 that are supported by incorporated subject matter in the present Application. (*See e.g.* Application page 4, ll. 10-13.) This incorporated subject matter was specifically cited in the Nov. 15 response. (*See, e.g.* page 13, introductory remarks.) The Examiner improperly declined to give patentable weight to the claim limitations provided in the amendments, and did not subject the limitations to examination. (*See* Feb. 3 Office Action, page 2.)

The Examiner's action is flawed in two fundamental respects.

- 1) The Examiner erroneously cites Rule 57(a) as requiring that priority/benefit must be claimed to a prior-filed application that is the source of essential subject matter. The Examiner is not correct. Rule 57(a) is a safe-harbor provision that provides that a prior-filed application to which priority/benefit is claimed may be treated as having been incorporated by reference, even though no explicit incorporation by reference is made within the application under examination. Rule 57(a) is irrelevant to the present application, because no such priority claim is made.

Rule 57(b) is an alternative manner of incorporating subject matter of a previously-filed application into the application under examination, e.g. explicit incorporation by reference. Rule 57(b) sets forth specific procedures for incorporation by reference, including specific language to be used in the incorporating statement. The Examiner has not alleged that the incorporating statement is deficient, and the Applicant respectfully asserts that it is not.

Accordingly, the present application properly incorporates the subject matter of US Patent Application No. 09/542,602, since issued as US Patent No. 7,334,038.

- 2) Based on the erroneous conclusion that the essential subject matter supporting the claim amendments was not properly incorporated by reference, the Examiner erroneously declined to examine the limitations of the amendments. While Rule 57(g) provides that incorporation by reference is not effective if the incorporation fails to comply with Rule 57 subsections (b), (c) or (d), as the Applicant points out above the incorporation by reference complies with Rule 57(b). Thus the Examiner's conclusion that the amended limitations should not be examined is incorrect.

The Applicants also respectfully note that MPEP § 608.01(p)(I) recites an example that is applicable in the current case. (*See* § 608.01(p)(I)(A), Example 2.) As the Applicant understands this Example, appropriate action by the Examiner would include a determination that the incorporated subject matter is essential subject matter, and issuing a rejection under § 112, first paragraph. The example also indicates that it is proper to amend the specification to include the essential subject matter in an after final amendment in compliance with Rule 116.

Accordingly, the Applicant amends herewith the Specification and the Drawings to include the essential subject matter. This material is the material previously incorporated by reference and contains no new matter. This amendment is timely, and must be entered by right, because the subject matter of the amendment was incorporated by reference in the present application as filed. (*See* MPEP § 608.01(p)(I)(A), Example 2.)

The Applicants respectfully assert that the improper application of Rule 57, and resulting final rejection without substantive examination of the claim amendments is clear error on the part of the Office. Accordingly, the Office's final rejection is prejudicial to the Applicant's rights under 35 U.S.C. § 102 ("a person shall be entitled to a patent unless..."). Thus, the Final Rejection is improper, and the Applicant respectfully requests that the Office either 1) allow the claims in their current form, or 2) withdraw the finality of the rejection and provide substantive examination of all claim limitations.

### **III. Rejection of Claims 48, 62 and 72 under 35 U.S.C. § 112, first paragraph**

The Examiner has rejected Claims 48, 62 and 72 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is based on the essential subject matter incorporated by reference as described above. The accompanying amendments to the

Specification and the Drawings incorporate the essential subject matter. Thus the rejection under § 112, first paragraph is overcome. Accordingly, the Applicant respectfully requests the Examiner to withdraw the §112, first paragraph rejection of Claims 48, 62 and 82 and allow issuance thereof.

**IV. Rejection of Claims 48, 51-72 and 75-85 under 35 U.S.C. § 102**

The Examiner has rejected Claims 48, 51-72 and 75-85 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,636,505 to Wang, *et al.* ("Wang"). The Applicant respectfully traverses the rejection because Wang fails to teach each and every limitation of amended Claim 1.

Claim 1 as previously amended includes the limitation

transmitting to said automation agent a copy of an extensible service location map of an extensible service bus, wherein said extensible service location map includes a listing of a plurality of extensible services included on said extensible service bus and server location information corresponding to each extensible service of the listing.

Wang as applied by the Office fails to teach transmitting an extensible service map to the automation agent as recited in amended Claim 48. As described above, the Examiner improperly declined to give this limitation patentable weight and did not examine it. Thus, the Office has failed to show that this limitation is taught by Wang, and Claim 48 is allowable over Wang as applied. Claims 62 and 72 are also allowable, mutatis mutandis. Claims 51-61, 63-70 and 75-85 are allowable at least because they each depend from an allowable base claim.

The Applicant therefore respectfully requests that the Office withdraw the rejection of Claims 48, 51-72 and 75-85 under §102 and provide a notice of allowance for these claims.

**V. Rejection of Claims 49-50 and 73-74 under 35 U.S.C. § 103**

The Examiner has rejected Claims 49-50 and 73-74 under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of U.S. Patent No. 6,091,713 to Lechleider, *et al.* ("Lechleider").

The Applicant respectfully traverses the rejection because the combination as applied by the Office fails to teach or suggest each and every limitation of the Claims.

As set forth above the Office has not shown that Wang teaches transmitting an extensible service location map as recited in amended Claims 48, 62 and 72. Likewise the Examiner has not cited Lechleider for teaching this feature of the claims. Moreover, because the Examiner did not substantively examine this feature, the Office has not even presented a proper *prima facie* case of obviousness of Claims 48, 62 and 72. Accordingly, Claims 49-50 and 73-74 are allowable over the asserted combination of Wang and Lechleider, at least because these claims each depend from an allowable base claim. The Applicant therefore respectfully requests that the Office withdraw the rejection of Claims 49-50 and 73-74 under §103 and provide a notice of allowance for these claims.

#### **VI. Rejection of Claims 62-85**

The Office rejects Claims 62-85 under the same reasoning as for Claims 48-61 without citing specific sections of the patent code. (See page 10.) The Applicant respectfully asserts that these claims are allowable at least for the reasons set forth above with respect to Claims 48-61. Accordingly the Applicant respectfully requests that the Office withdraw the rejection of Claims 62-85 under the applicable code sections and provide a notice of allowance for these claims.

#### **VII. Rejection of Claims 48, 51-72 and 75-85 under 35 U.S.C. §103**

The Examiner has rejected Claims 48, 51-72 and 75-85 under 35 U.S.C. §103(a) as being unpatentable over Wang in view of U.S. Patent No. 6,529,784 to Cantos, *et al.* ("Cantos"). The Applicant respectfully traverses the rejection because the combination as applied by the Office fails to teach or suggest each and every limitation of the Claims.

As set forth above the Office has not shown that Wang teaches transmitting an extensible service location map as recited in amended Claims 48, 62 and 72. Moreover, the Applicant does not find a suggestion within the cited portions of Wang of transmitting an extensible service location map. Furthermore, Cantos as applied in the Office Action fails to cure the deficiency of Wang. Accordingly, Claims 48, 51-72 and 75-85 are allowable over the asserted combination of Wang and Cantos, at least because these claims each depend from an allowable base claim. The Applicant therefore respectfully requests that the Office withdraw the rejection of Claims 48, 51-72 and 75-85 under § 103 and provide a notice of allowance for these claims.

#### **VIII. Rejection of Claims 49 and 73 under 35 U.S.C. § 103**

The Examiner has rejected Claims 49 and 73 under 35 U.S.C. § 103(a) as being unpatentable over Wang and Cantos in view of Lechleider. The Applicant respectfully traverses the rejection because the combination as applied by the Office fails to teach or suggest each and every limitation of the Claims.

As set forth above the Office has not shown that the combination of Wang and Cantos teaches or suggests transmitting an extensible service location map as recited in amended Claims 48, 62 and 72. As further set forth above Lechleider fails to cure the deficiency of the combination of Wang and Cantos. Accordingly, Claims 48 and 72 are allowable over the asserted combination of Wang, Cantos and Lechleider at least because these claims each depend from an allowable base claim. The Applicant therefore respectfully requests that the Office withdraw the rejection of Claims 49 and 73 under § 103 and provide a notice of allowance for these claims.

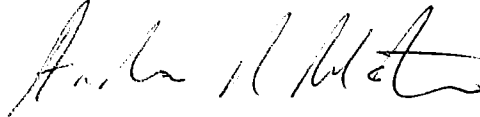
## **IX. Conclusion**

In view of the foregoing amendment and remarks, the Applicant respectfully asserts that all of the Claims currently pending in this application are in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 48-85.

The Applicant requests the Examiner of record to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

**HITT GAINES, P.C.**

A handwritten signature in black ink, appearing to read "Andrew R. Ralston", is written over the printed name.

Andrew R. Ralston  
Registration No. 55,560

Dated: April 4, 2011

P.O. Box 832570  
Richardson, Texas 75083  
(972) 480-8800